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United States Patent &amp; Trademark Office; U.S. DEPARTMENT OF COMMERCE

<b>PRE-APPEAL BRIEF REQUEST FOR REVIEW</b>	Docket Number (Optional) 047092.00137
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed Name _____	Application Number:  10/073,216  Filed: February 13, 2002
	First Named Inventor:  Tarja PIRTTIMAA
	Art Unit: 2136
	Examiner: Pramila PARTHASARATHY

**Mail Stop AF**

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ Applicant/Inventor.
- ☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under  
37 CFR 3.73(b) is enclosed
- ☒ Attorney or agent of record.  
Registration No. 58,178

- ☐ Attorney or agent acting under 37 CFR 1.34.  
Reg. No. is acting under 37 CFR 1.34 \_\_\_\_\_

  
Signature

Peter Flanagan

Typed or printed name

703-720-7800

Telephone number

July 2, 2007

Date

NOTE: Signatures of all of the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

- ☐ \*Total of \_\_\_\_\_ forms are submitted.



## PATENT APPLICATION

### IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of:

Confirmation No.: 4809

Tarja PIRTTIMAA, et al.

Group Art Unit: 2136

Serial Number: 10/073,216

Examiner: Pramila Parthasarathy

Filed: February 13, 2002

Atty. Docket No.: 047092.00137

For: METHOD AND NETWORK ELEMENT FOR PROVIDING SECURE ACCESS TO  
A PACKET DATA NETWORK

### Pre-Appeal Brief Request for Review

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

July 2, 2007

Sir:

In accordance with the Pre-Appeal Brief Conference Pilot Program guidelines set forth in the July 12, 2005, Official Gazette Notice, Applicants hereby submit this Pre-Appeal Brief Request for Review of the final rejections of claims 1-9 and 13-36 in the above identified application. Claims 1-9 and 13-36 were finally rejected in the Office Action dated January 31, 2006. Applicants have concurrently appealed these rejections and submit therewith this Pre-Appeal Brief Request for Review, which sets forth clear errors in the Office Action.

Claims 1-36 were rejected on the basis of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 6,788,676 ("the '676 patent"). This rejection contains clear error, because it does not apply the two-way test.

The present application has an earlier filing date than the '676 patent, which the Office Action does not dispute. Accordingly, in order to establish a *prima facie* case of obviousness-type double-patenting, it is necessary for the Office Action to address a two-

way test, which the Office Action has not addressed. This failure to address the two-way test constitutes clear error and mandates that the rejection be reversed.

According to MPEP 804(B)(1)(b), “[i]f the patent is the later filed application, the question of whether the timewise extension of the right to exclude granted by the patent is justified or unjustified must be addressed.” (emphasis added) The MPEP goes on to explain that a two-way test is to be applied when the applicant could not have filed the claims in a single application and there is administrative delay.

The Office Action does not establish that the applications could have been filed together and the lack of common inventors suggests that they could not have been filed together. Moreover, the more than three years that it took for the USPTO to issue a first Office Action in this application clearly qualifies as administrative delay. Because the record makes this delay clear, the Office Action is required to show either how the applications could have been filed together or how the claims of the ‘676 patent are obvious in view of the claims of the present application as well as how the claims of the present application are obvious in view of the ‘676 patent. The Office Action does not include any such analysis. Accordingly, the Office Action does not establish a *prima facie* case for obviousness-type double-patenting, and this constitutes clear error that mandates reversal of the rejection.

This principle was explained in a response filed November 13, 2006. However, it appears that the Examiner has failed to grasp the significance of the ‘676 patent being later filed. The Office Action, at item 2, states that “The obvious-type [sic] rejection was based upon the conflicting invention is [sic] claimed in the [sic] Patent 6,788,676 by a different inventive entity that is commonly assigned, even though there is no common inventor.” This response seems to indicate that the Examiner has overlooked the two-way test of MPEP 804(B)(1)(b).

The two-way test that **MUST** be applied here, and has not been applied, is that the Examiner must establish **BOTH** that the claims of the present application are obvious in view of the claims of the ‘676 patent **AND** that the claims of the ‘676 patent are obvious in view of the claims of the present application. The Office Action, at item 6, only applies the first part of the test, and not the second part of the test. Accordingly, the rejection is incomplete and does not constitute a *prima facie* case of obviousness-type double patenting when the

alleged conflicting patent is later filed. Thus, it is respectfully requested that the rejection be reversed.

Claims 1-9 and 13-36 were rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,996,087 of Ejzak ("Ejzak"). This rejection also constitutes clear errors in correlating Ejzak to what is claimed.

Ejzak generally relates to a communication system including an **interworking mobile switching center** for call termination. As explained at column 3, lines 52-59, Ejzak describes that a packet-switched domain 131 can including a serving GPRS node (SGSN) 132 and a gateway GPRS support node (GGSN) 133. The SGSN 132 provides packet mobility management, authentication, session management, accounting, mapping of IP addresses to IMSI, maintenance of mobile state information, and interfacing with the GGSN 133. The GGSN 133 can provide internetworking between the SGSNs and external packet data networks using IP.

As explained at column 3, line 60 to column 4, line 9, Ejzak indicates that the IMSI 141 can include various components including a CSCF 143. The CSCF 143 is a signaling entity for call/session control. The CSCF 143 manages SIP sessions, provides features/services and coordinates with other network elements for session control, feature/service control and resource allocation. The CSCF 143 functions can include an incoming call gateway, a call control function, a serving profile database, and address handling. CSCF 143 can perform GMSC emulation as needed to support call delivery to IMS-homed subscribers served by an MSC server 152, and not being served by the IMSC 201. For subscribers that are served by the IMSC 201, the CSCF 143 provide features and services of the CS domain that are the same as those being provided for subscribers being serviced by the MSC server 152.

Claims 1 and 2 recite "initiating a protection processing based on a result of said comparing," claim 13 recites "protecting means for initiating a protection processing based on a comparing result of said comparing means." Ejzak is silent as to at least these features of the presently pending claims. The Office Action cited column 3, line 52, to column 4 line 9, and Summary as disclosing the above-identified features, but the cited passages make no mention either of initiating a **protection processing** or of initiating any processing **based on**

comparing first source information and second source information. Going beyond the cited portion of the reference, and even assuming the BGSCF 143, which is described at column 4, lines 26-33, performs “protection processing” (not admitted), there is clearly no disclosure or suggestion that the BGSCF 143 performs protection processing based on comparing first source information and second source information. Accordingly, the correspondence of Ejzak to what is claimed constitutes clear error.

In the Response to Arguments section, item 3, the Office Action took the position that “The Examiner broadly reads, ‘a protection process is initiated on a result (**not definitive**) of comparing first and second source information” (parenthetical and emphasis in Office Action). More specifically, the Office Action took the position that Ejzak’s authentication, accounting, and mapping of IP addresses corresponds to the claimed comparing source address information, that Ejzak’s session management corresponds to the claimed initiation of protection processing, and that Ejzak’s providing secure access to a packet data network corresponds to the claimed subscriber profile management and service authentication to a packet-switched network, citing column 3, line 52, to column 4, line 9, and column 6, lines 45-54.

The Office Action’s analysis contains a further clear error. Rhetorically, one may ask “How could the disclosure of Ejzak, at column 3, line 53, to column 4, line 9, that the “SGSN provides packet mobility management, authentication, session management, accounting, mapping of IP addresses to IMSI” possibly correspond to comparing a first (received) source information and second source information?” The answer, of course, is that it cannot. The Office Action’s correspondence is clearly erroneous.

Ejzak does not compare a first (received) source information and second source information. Ejzak’s mapping is a “a straightforward mapping of call states, messages, and message parameters between 3GPP TS 24.008 and SIP,” (Ejzak, column 13, line 58) and “a straightforward mapping of call states, messages, and message parameters between SIP and 3GPP TS 24.008” (Ejzak, column 14, line 44). Such conversion is similarly described in the background section of the present application at page 3, lines 4-35. Such conversion, however, is clearly not a comparison of first and second source information.

The Office Action cannot justify this clear error by a comparison to the example embodiments of the present invention discussed in the specification. In the specification, example embodiments compare address information in different protocol headers in the message (or in the message and a database), which can help to prevent fraudulent user attack. There is nothing similar in Ejzak that could create a justification for the Office Action's clear error above. Indeed, in Ejzak the focus is on a new server that is able to convert the air interface media flow into RTP/UDP/IP. If there are corresponding parameters used in different protocol headers (such as SIP and IP) in the message, Ejzak gives no hint that they would be compared. This difference reinforces the fact that the rejection's correspondence between Ejzak's mapping and the claimed "comparing" is clearly erroneous. Thus, reversal of the rejection is clearly required.

Reconsideration and withdrawal/reversal of the rejections, in view of the clear errors in the Office Action, is respectfully requested. In the event this paper is not being timely filed, Applicants respectfully petition for an appropriate extension of time. Any fees for such an extension together with any additional fees may be charged to Counsel's Deposit Account 50-2222.

Respectfully submitted,

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PCF:mmi

Enclosures: PTO/SB/33 Form; Notice of Appeal; Petition for Extension of Time; Check No. 16652